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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/662,958 | 09/15/2003 | Shannon Walker Williams | 035706-0106 | 1040 |
| 26371 | 7590 | 11/08/2005 | | |
| FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308 | | | EXAMINER KIM, CHRISTOPHER S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3752 | |

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/662,958 | Applicant(s) WILLIAMS ET AL. | |
| | Examiner Christopher S. Kim | Art Unit 3752 | |

TW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2005 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's election of Species A, figure 5 in the reply filed on March 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claim 27 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 14, 2005.

Claim Rejections - 35 USC § 112

5. Claims 1-26 and 28-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "...a nozzle rigidly coupled to the container..." and claim 37 recites "...a nozzle fixedly secured adjacent to the container..." The plain meaning of the terms "rigidly coupled" and "fixedly secured" require that the nozzle be non-movably and non-flexibly attached to the container. The disclosure, as originally filed, fails to teach a nozzle rigidly coupled to or fixedly secured adjacent to the container. Rather, the specification teaches the opposite. Paragraph 23 teaches that the nozzle 34 is coupled to the stem 40. Paragraphs 20 and 21 teach that the valve assembly 52 is actuated by the movement of stem 40. Again, paragraph 26 teaches that movement of trigger 48 causes the stem 40 to move. Additionally, paragraph 26 teaches that the natural resilient nature of stem 40 and nozzle 34 return the trigger 38 to the non-dispensing state once the trigger 48 is released. In order for the stem 40 and nozzle 34 to be resilient, they must be flexible.

Claim 22 recites "...the tube permanently extends proximate to the side surface." The disclosure, as originally filed, fails to teach the "permanent" nature of the tube extending proximate the side surface. Rather, the specification, in paragraph 21, teaches that "valve assembly 52 may include a dip tube 54 that is configured to extend

along a bottom side of container 32 when container 32 is in a horizontal or a vertically inclined orientation (i.e. when the trigger of actuator 36 is substantially along the top side of container 32)."

The application as originally filed does not appear to disclose "the depressment surface not extending radially outwardly beyond the housing" recited in claim 33.

6. Claims 1-26 and 28-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "...a nozzle rigidly coupled to the container..." and claim 37 recites "...a nozzle fixedly secured adjacent to the container..." Because the plain meaning of the terms "rigidly coupled" and "fixedly secured" contradict the disclosure in the specification as outlined above, the metes and bounds of the claimed invention cannot be determined.

Claim 38 recites the limitation "the snuff box" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "the snuff box" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. Claims 1-3, 12, 15, 17-20, 31, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,400,231).

Gebauer discloses an applicator comprising: a propellant container 10; a nozzle 32; an actuator 29; a trigger 28; a housing 13, 35.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

Regarding claim 11, Gebauer discloses a cap 35.

8. Claims 1-3, 15, 17, 19-21, 24-26, 28-30, 34, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Beres et al. (3,305,144).

Beres discloses an applicator comprising: a container 10; a nozzle 26; an actuator 70; a housing 58, 64; an aerosol valve 14.

The nozzle 26 is in-line with the longitudinal axis of the container when oriented as such.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Beres is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 21, the aerosol container 10 of Beres inherently has a dip tube.

9. Claims 1-3, 12, 15, 17-20, 31, 35, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,768,032).

Gebauer discloses an applicator comprising: a propellant container 1; a nozzle 18; an actuator 23; a trigger 20; a housing 5, 12; a cap 25.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a

compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

Regarding claim 35, Gebauer discloses a housing 5, 12, 25

10. Claims 1, 3, 15, 19-20, 28-30, 31, 32, 35, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Knight et al. (3,306,252).

Knight discloses an applicator comprising: a propellant container 11; a nozzle 43; an actuator 19; a housing 14; a valve 26.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Knight is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 11, Knight discloses a cap 14

11. Claims 1-4, 6, 10, 11, 14, 15, 17-21, 23, 31, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,313,930).

Gebauer discloses an applicator comprising: a propellant container 10; a nozzle 16a; an actuator 20; a trigger 18; a housing 13, 14; a dip tube 23.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 11, Gebauer disclose a cap 14.

12. Claims 1, 3, 4, 6, 9, 15, 17-21, 28-30, 34, 36, 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Meshberg (2,914,222).

Meshberg discloses, in figure 6, an applicator comprising: a propellant container 15; a nozzle 38; an actuator 39; a housing 11.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Meshberg is not prohibited from being used as a nail polish applicator. Note that Meshberg discloses, in column 1, lines 45-50, dispensing cosmetics.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 21, the aerosol container 11 of Meshberg inherently has a dip tube.

Claim Rejections - 35 USC § 103

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebauer (2,171,501).

Regarding claim 16, Gebauer discloses the limitations of the claimed invention with the exception of the diameter of the container proximate the actuator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have limited the container outer diameter proximate the actuator to not greater than 1.0 inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

14. Claims 1-3, 15, 17, 19, 20, 21, 24, 25, 26, 28, 29, 30, 34, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (3,130,734) in view of Beres et al. (3,305,144).

Ellis discloses dispensing a nail polish using a pressurized can 12.

Beres discloses an applicator comprising: a container 10; a nozzle 26; an actuator 70; a shousing 58, 64; an aerosol valve 14. The nozzle 26 is in-line with the longitudinal axis of the container when oriented as such. Regarding claim 21, the aerosol container 10 of Beres inherently has a dip tube.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have used the device of Beres to spray nail polish of Ellis for mobility and manipulation of the nozzle without moving the container (Beres, column 2, lines 15-31).

Response to Arguments

15. Applicant's arguments filed August 25 have been fully considered but they are not persuasive.

Regarding the rejection of claim 33 under 35 U.S.C. 112, first paragraph, applicant argues that the specification discloses the nose 58 having an outer surface that is generally flush with the outer surface of trigger 48 when trigger 48 is in the non-dispensing position, and therefore, supports the recitation "the depressment surface not extending radially outward beyond the housing." The disclosure applicant points to in the specification does not support the negative recitation of claim 33. If applicant believes that the recitation "the depressment surface not extending radially outward beyond the housing" claims a nose 58 having an outer surface that is generally flush with the outer surface of trigger 48 when trigger 48 is in the non-dispensing position, applicant should amend claim 33 as such.

Regarding applicant's arguments that the prior art does not disclose nail polish, the argument has been addressed in the prior Office action. Additionally, applicant's claimed invention does not limit "nail polish." The fluids in the prior art has the ability to be applied to the nail.


Applicant argues that a dip tube is not inherent in Meshberg. If a dip tube is not inherent in Meshberg, dispensing can only be accomplished when the device is inverted. Meshberg discloses, in column 4, lines 3-5, "When it is desired to dispense a predetermined quantity of fluid from the container, the container is pushed upwardly."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Christopher S. Kim
Primary Examiner
Art Unit 3752

CK